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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/067,021	02/04/2002	Gary J. Condon	K-1859	4194

7590 08/21/2003

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EXAMINER

ROSENBAUM, MARK

ART UNIT

PAPER NUMBER

3725

DATE MAILED: 08/21/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/067,021	CONDON, GARY J.
	Examiner Mark Rosenbaum	Art Unit 3725

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 30 June 2003.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

4) Claim(s) 1-22 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-22 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) Notice of References Cited (PTO-892)  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.

4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.  
5) Notice of Informal Patent Application (PTO-152)  
6) Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

Claims 5,13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear how these claims further **structurally** limit the claims they depend upon.

### ***Claim Rejections - 35 USC § 102***

Claims 10,11,14,17-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Davenport. Note figure 1 which shows a tooth body with an insert.

### ***Claim Rejections - 35 USC § 103***

Claims 12,13,15,16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davenport. The limitations of these claims would have been obvious design choices only once the basic apparatus was known. For example, the exact height of the insert would depend on several factors such as material being treated and desired maintenance intervals.

Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kottmann. See paper number 3 for this rejection. Furthermore, the omission of elements and their function e.g. trailing insert does not result in patentable subject matter. Also, the tooth bodies of Kottman are considered to be attached to the tooth carriers in an integral manner.

Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art (APA) in view of Davenport. APA is the apparatus discussed in the

first few pages of the specification which includes a rolling drum mill having two rolls with integral teeth. The use of integral teeth results in increased maintenance costs due to replacement costs. Davenport solves this problem by disclosing similar apparatus including the use of replaceable tooth bodies with inserts. In order to reduce maintenance costs, it would have been obvious for one of ordinary skill in the art to modify APA by using replaceable tooth bodies, taught to be desirable by Davenport. The remaining limitations would have been obvious design choices only once the basic apparatus was known. For example, the omission of elements and their function e.g. trailing insert, does not result in patentable subject matter.

#### ***Response to Arguments***

Applicant's arguments filed 6/30/03 have been fully considered but they are not persuasive. Concerning Kottmann, integral members are attached to each other. The 112 rejection remains appropriate because the manner in which an element is formed does not further structurally limit that element. The use of Davenport to reject the claims is appropriate because applicant has amended the claims to specifically claim a replaceable tooth body and this is clearly shown in Davenport, a reference of record prior to this office action.

#### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Rosenbaum whose telephone number is 703-308-1788. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alan Ostrager can be reached on 703-308-3136. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.



Mark Rosenbaum  
Primary Examiner  
Art Unit 3725

MR